



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/560,316

05/02/2006

Anthony Miles

002918.00031

4943

22907 7590 06/08/2010

BANNER & WITCOFF, LTD.

1100 13th STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT

PAPER NUMBER

2439

MAIL DATE

DELIVERY MODE

06/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,316	Applicant(s) MILES ET AL.	
	Examiner MICHAEL J. SIMITOSKI	Art Unit 2439	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/9/05, 1/12/10</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2439

DETAILED ACTION

1. The IDS of 12/9/05, 1/12/10 were received and considered.
2. Claims 1-38 are pending.

Information Disclosure Statement

3. The information disclosure statement filed 12/9/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The non-patent literature cited does not appear in the file history. It has been placed in the application file, but the information referred to therein has not been considered.

Election/Restrictions

4. Claims 39-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/15/10. Claims 39-50 have been cancelled by applicant.

Claim Objections

5. Claims 1-18 are objected to because of the following informalities: Appropriate correction is required.
- a. Regarding claim 1, line 8, “an second” should be replaced with “a second”.
 - b. Regarding claim 1, line 11, “second” should be replaced with “a second”.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Art Unit: 2439

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 19-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

c. Regarding claim 19, the claim is directed to a method of manufacturing a disc, but, as there are no limitations directed to physical manufacturing, the method appears to recite only data structure-formatting steps. As such, the method appears to be an abstract idea, thus not falling within the statutory classes of invention defined under 35 U.S.C. §101.

d. Regarding claim 38, the broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP §2111.01. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. §101 by adding the limitation “non-transitory” to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. Further, an amendment to the specification to provide sufficient antecedent basis for the claim terminology, such as “non-transitory” may be necessary and would not typically raise the issue of new matter.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2439

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 16-18 and 19-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

e. Regarding claims 16-18, the claims are directed to an optical disc, but recite limitations relating to a player's capabilities. This renders the claim scope indefinite, as it is unclear how or if such a limitation affects the actual optical disc.

f. Regarding claims 16-18, the claims use the term "capable". However, the scope of the claims are indefinite as it is unclear what renders a player "capable" to perform an action such that a limitation of the format could be used to limit the player.

g. Regarding claim 19, the claim is directed to a method of manufacturing a disc, but the claim does not recite steps leading to a disc manufacture. Therefore, the scope of the claim is unclear.

h. Regarding claims 33-35, the claims are directed to manufacturing an optical disc, but recite limitations relating to a player's capabilities. This renders the claim scope indefinite, as it is unclear how or if such a limitation affects the manufacturing of the optical disc.

i. Regarding claims 33-35, the claims use the term "capable". However, the scope of the claims are indefinite as it is unclear what renders a player "capable" to perform an action such that a limitation of the format could be used to limit the player.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2439

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3-7, 16-19, 21-25, 33-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,988,206 to Alcalay et al. (**Alcalay**).

Regarding claims 1 and 16-18, Alcalay teaches an optical disc (Fig. 1) carrying a session (Fig. 4) including a table of contents (col. 5, lines 65-67) and a program area (col. 5, lines 55-57) containing at least one track (correct Q channel data in reserved bits, col. 6, lines 47-52), the table of contents indicating a first start position (lead-in to program area, col. 5, lines 53-54) wherein: a. a data portion is located at first start position and is arranged to cause a read failure by a first optical disc reader, which reads at said first start position (Q channel is altered, causing invalid read, col. 6, lines 3-6 and 10-13 and is optionally also encrypted, col. 7, lines 32-40); b. the track is located at a second start position different from said first start position (col. 6, lines 47-52); and c. the session further includes an index (authorized software stored in second session, col. 7, lines 32-40) indicating said second start position, such that a second optical disc reader is enabled to read the track by reading the second start position from the index (using authorized software to recover correct data, col. 7, lines 32-40).

Regarding claim 3, Alcalay discloses wherein the index is located at a predetermined position within the session, such that it is recognized by the second optical disc reader (authorized reader, col. 7, lines 32-40).

Regarding claim 4, Alcalay discloses wherein the program area includes one or more subchannels (col. 6, lines 53-56) arranged to cause a third optical disc reader to read the track and ignore the data portion (col. 6, lines 39-41, col. 7, lines 1-3).

Regarding claim 5, Alcalay discloses wherein the one or more subchannels are arranged to cause the third optical disc reader to ignore the index (col. 6, lines 39-41, col. 7, lines 1-3).

Art Unit: 2439

Regarding claim 6, Alcalay discloses wherein the third optical disc reader is an audio CD player and the track is an audio track (col. 6, lines 39-41, col. 7, lines 1-3).

Regarding claim 7, Alcalay discloses wherein the data portion includes unrecoverable data arranged to cause a read error in the first optical disc player (Q channel is altered, causing invalid read, col. 6, lines 3-6 and 10-13 and is optionally also encrypted, col. 7, lines 32-40).

Regarding claim 19, the claim is substantially equivalent to claim 1 and is therefore rejected under similar rationale.

Regarding claims 21-25, the claims are substantially equivalent to claims 3-7, respectively, and are therefore rejected under similar rationale.

Regarding claims 33-35, the claims are substantially equivalent to claims 16-18, respectively, and are therefore rejected under similar rationale.

Regarding claim 36, Alcalay discloses wherein the optical disc is an optical disc master (col. 5, lines 35-38).

Regarding claim 38, the claim is substantially equivalent to claim 19 and is therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 8-15 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alcalay**, as applied to claims 1 and 19 above, in view of U.S. Patent Application Publication 2004/0103115 to Vandewater et al. (**Vandewater**).

Art Unit: 2439

Regarding claims 8-11 and 15, Alcalay discloses storing a player program executable on the disc (col. 2, lines 58-65), but lacks wherein the data portion includes a pointer. However, Vandewater teaches a monitoring program for copy protection (§28) that is automatically executable via a pointer in a data session (§24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcalay's disc to include, in the data portion, a pointer to a player program executable. One of ordinary skill in the art would have been motivated to perform such a modification to automatically monitor the disc usage, as taught by Vandewater.

Regarding claims 12-14, Alcalay discloses storing a player program executable on the disc (col. 2, lines 58-65), but lacks including a boot sector pointing to the program. However, Vandewater teaches a monitoring program for copy protection (§28) that is automatically executable via a boot sector in the disc (inf file, §24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcalay's disc to include, in the data portion, a boot sector arranged to cause execution of a player program executable. One of ordinary skill in the art would have been motivated to perform such a modification to automatically monitor the disc usage, as taught by Vandewater.

Regarding claims 26-29, the claims are substantially equivalent to claims 8-11, respectively, and are therefore rejected under similar rationale.

Regarding claims 30-32, the claims are substantially equivalent to claims 12-14, respectively, and are therefore rejected under similar rationale.

14. Claims 2, 20 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alcalay**, as applied to claims 1, 19 and 36 above, in view of what was known in the art at the time the invention was made.

Art Unit: 2439

Regarding claims 2 and 20, Alcalay lacks wherein the index is a video CD index and said second optical disc reader is a video CD compatible optical disc reader. However, video CDs using an index to locate video data were well-known in the art at the time the invention was made (as also stated in Applicant's specification). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcalay such that the index is a video CD index and said second optical disc reader is a video CD compatible optical disc reader. One of ordinary skill in the art would have been motivated to perform such a modification to allow the content to be used by a video CD compatible player, as was well-known in the art.

Regarding claim 37, Alcalay lacks explicitly manufacturing one or more playable optical discs directly or indirectly from the optical disc master. However, it was well-known in the art at the time of the invention to create a master disc (as does Alcalay) and to further use that master disc in the creation of copies. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcalay to explicitly include manufacturing one or more playable optical discs directly or indirectly from the optical disc master. One of ordinary skill in the art would have been motivated to perform such a modification to conform to standard practices in optical disc production, as was well-known to a skilled artisan at the time the invention was made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. SIMITOSKI whose telephone number is (571)272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571)272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2439

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 4, 2010

/Michael J Simitoski/

Primary Examiner, Art Unit 2439